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EXAMINER

PRYOR, ALTON NATHANIEL

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12/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Detailed Action

Applicant's arguments filed 7/28/08 have been fully considered but they are not persuasive. See argue below.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,4-12,14-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,26-12 of U.S. Patent No. 6793914. Although the conflicting claims are not identical, they are not patentably distinct from each other because both USPN '914 and instant invention make claim to a composition comprising iron chelators such as DTPA (see column 5 lines 30-45 in USPN), organic amines such as amine having at least one C1-C10 terminal hydrocarbyl group (see column 6 lines 62-67 in USPN), water present at 5 – 50% (see column 5 last

paragraph in USPN), volatile propellants are excluded from the composition (see abstract in USPN).

Response to Applicants' argument

Applicant argues:

1) The claims of the USPN '914 recite iron chelators being selected from a group of very specific compounds, i.e. N,N'-ethylenebis[2-(2-hydroxyphenyl)glycine, triethylenetetraaminehexaacetic acid, and diethylenetriaminepentaacetic acid, whereas instant claims are required to have an organic cation that have a protonated or quaternized amine;

2) Instant claim requirement is that the protonated or quaternized amine that forms the organic cation has 0 to 3 hydroxyl groups per N-substituent and at least one N-substituent having a C1-C10 terminal hydrocarbyl group;

3) USPN '914 claims comprise an alcohol and solubility promoter, whereas instant claims do not recited alcohols.

The Examiner argues:

1) Current claim 12 specifically recites diethylenetriaminepentaacetic acid as recited in claims recited in '914;

2) The claim to the organic amine in '914 meets the instant claim to a protonated or quaternized amine having no hydroxy groups. This is because '914 at column 6 lines 62-67 it is taught that cyclohexylamine serves as the organic amine.

3) USPN '914 claims recite all the limitations recited in instant claims; Although claims in '914 require an alcohol and a solubility promoter (can be an organic amine) as

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additional components in comparison to claims recited in instant application, the claims recited in '914 meet all the instant claim limitations. Therefore, the claims recited in '914 make obvious the instant claims.

Claims 1,4-12,14-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,6-9,13 of U.S. Patent No. 6503490. Although the conflicting claims are not identical, they are not patentably distinct from each other because both USPN '490 and instant invention make claim to a composition comprising transition metal chelators (salt having an organic cation) such as DTPA and cyclohexylamine, organic amines such as amine having at least one C1-C10 terminal hydrocarbyl group (see column 5 lines 5-29 in USPN), water present in less than 50% (see column 7 lines 41-47 in USPN), volatile propellants are excluded from the composition.

Response to Applicants' argument

Applicant argues:

1) USPN '490 claims require phenolic/enolic component, whereas instant claims do not require phenolic/enolic component.

The Examiner argues:

1) USPN '490 claims recite all the limitations recited in instant claims; Although claims in '490 require a phenolic/enolic component as an additional component in comparison to the claims recited in instant application, the claims recited in '490 meet all the instant claim limitations. Therefore, the claims recited in '490 make obvious the instant claims.

Claims 1,4-12,14-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,7,8,12-16 of copending Application No. 10/895,179. Although the conflicting claims are not identical, they are not patentably distinct from each other because both USPN '179 and instant invention make claim to a composition comprising iron chelators such as DTPA (see column 5 lines 30-45), organic amines such as amine having at least one C1-C10 terminal hydrocarbyl group (see column 6 lines 62-67), water present at 5 – 50% (see column 5 last paragraph), volatile propellants are excluded from the composition (see abstract).

Response to Applicants' argument

Applicant argues:

1) The claims of the USAN '179 recite iron chelators being selected from a group of very specific compounds, i.e. N,N'-ethylenebis[2-(2-hydroxyphenyl)glycine, triethylenetetraaminehexaacetic acid, and diethylenetriaminepentaacetic acid, whereas instant claims are required to have an organic cation that have a protonated or quaternized amine;

2) Instant claim requirement is that the protonated or quaternized amine that forms the organic cation has 0 to 3 hydroxyl groups per N-substituent and at least one N-substituent having a C1-C10 terminal hydrocarbyl group;

3) USAN '179 claims comprise an alcohol and solubility promoter, whereas instant claims do not recited alcohols.

The Examiner argues:

1) Current claim 12 specifically recites diethylenetriaminepentaacetic acid as recited in claims recited in '179;

2) The claim to the organic amine in '179 meets the instant claim to a protonated or quaternized amine having no hydroxy groups. This is because '179 at column 6 lines 62-67 it is taught that cyclohexylamine serves as the organic amine.

3) USAN '179 claims recite all the limitations recited in instant claims; Although claims in '179 require an alcohol and a solubility promoter (can be an organic amine) as additional components in comparison to claims recited in instant application, the claims recited in '179 meet all the instant claim limitations. Therefore, the claims recited in '170 make obvious the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/
Primary Examiner, Art Unit 1616